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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,600	04/18/2001	Sylvain Kravtchenko	05725.0883-00	7876

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EXAMINER
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ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

7

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 7

# Office Action Summary

Application No.

09/836,600

Applicant(s)

KRAVTCHENKO ET AL.

Examiner

Eisa B Elhilo

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1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-68 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 1-68 are pending in this application.

## **DETAILED ACTION**

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 53-68 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-48 of co-pending Application No. 09/836411. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced co-pending application and would be covered by any patent granted on that co-pending application since the referenced co-pending application and the instant application are claiming common subject matter, as follows: Both claims are drawn to the same method for dyeing hair by using compositions comprising similar dyeing ingredients such as enzymatic oxidizing system, oxidation bases and direct dyes. The composition having similar properties differing only in that the instant claims have not recite the sources and the amount of the oxidizing enzymes used in the dyeing compositions.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a dyeing composition because the claims 1-48 of the co-pending application No. 09/836411 disclose the same oxidizing enzymes as claimed and further, optimize the amount of these enzymes and teach the origin sources from which these enzymes are derived. Therefore, the person of the ordinary skill in the art would expect such a composition to have similar properties to those claimed. Absent unexpected results.

***Claim Rejections - 35 USC § 103***

2 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US' 5,993,491) in view of de la Mettrie et al. (WO' 99/17730), and Schmitt et al. (US' 5,865,853).

Lim (US' 491) teaches a hair dyeing comprising 1-(4-aminophenyl) pyrrolidine compounds having formulae similar to the claimed formula when in the claimed formula (I) R1, R2 and R3 are hydrogen atoms (see col. 4, formula 2), when in the claimed formula R1 and R3 are each hydrogen atom and R2 is a -CH<sub>2</sub>OH group (see col. 4, formula 1), when in the claimed formula R1 is hydrogen atom, R2 is a -CH<sub>2</sub>OH group and R3 is a hydroxyl group (see col. 4, formula 1a). Lim teaches the 1-(4-aminophenyl) pyrrolidine compounds in the amount of 0.01 to 10% by weight based on the total weight of the composition (see col. 7, lines 44-48). Lim also

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teaches a hair dyeing composition acid addition salts such as sulfate salt (see col. 3, lines 7-8), from 0.01 to 10% of couplers such as m-phenylenediamine (1-3-diaminobenzene) (see col. 6, line 16 and col. 7, lines 49-51), from 1% to 15% of organic solvent (see col. 8, lines 23-29), from 0.1 % to about 15% of nonionic surfactant (see col. 9, lines 39-40), anti-oxidants (reducing agents) (see col. 8, line 37), from 0.1% to about 10% of polymeric thickeners (see col. 9, lines 1-4), from 1% to 15% of oxidants such as hydrogen peroxide and perborates (see col. 9, lines 10-16), fatty alcohols (see col. 8, line 18) and alkaline reagents such as ammonium hydroxide to adjust the pH (see col. 10, lines 10-12). Lim also teaches a hair dyeing composition that may be formulated in a solution, cream, lotion or emulsions having pH in the ranges of 5 to 11 (see col. 8, lines 6-8 and col. 10, line 8). Lim further teaches a method for dyeing hair comprising mixing the dyeing composition described above with the oxidant shortly before use and applying to the hair and at the end of coloring application (approximately 5 to 45 minutes), the composition is washed from the hair with ordinary water rinse followed by a shampoo. The application temperature is in the range of about 150 C. to 500C (see col. 10, lines 24-41). Lim furthermore, teaches a dyeing composition provided in a kit or packaged form ready for mixing by the used (see col. 11, lines 1-3).

The instant claims differ from the reference by reciting a hair dyeing composition comprising dyeing ingredients such as enzymatic oxidizing system as oxidizing agents, cationic direct dyes and nitrobenzene direct dyes

De la Mettrie (WO' 730) teaches in analogous art a hair dyeing composition comprising from 0.01 to 20% of at least one enzyme of 2-electron oxidoreductase such as pyranose oxidase (see page 4, lines 26-29 and page 5, lines 4-6), peroxidase enzyme (see page 32, claim 32, line

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20), from 0.001 to 10% of cationic direct dyes having formulae similar to those claimed (see page 52 to page 75) and direct dyes of nitrobenzene compounds (see page 2, line 3).

Schmitt (US' 853) in another analogous art teaches a hair dyeing composition comprising direct dyes of nitrobenzene compounds similar to those claimed (see col. 3, lines 8-30).

Therefore, in view of the teachings of the secondary references, one having ordinary skill in the art would have been motivated to modify the primary reference by using enzymatic oxidizing system as oxidizing agents and direct dyes to make such a dyeing composition. Such modification would be obvious because one would expect that the use of oxidizing enzymes and direct dyes as taught by de la Mettrie and Schmitt would be similarly useful and applicable to the analogous composition taught by Lim.

#### ***Allowable Subject Matter***

3      Claim 5 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record does not teach, disclose or suggest a hair dyeing composition comprising oxidation dye of the claimed formula (I) wherein R1 and R3 are each a hydrogen atoms and R2 is a -CONH2 group.

#### ***Conclusion***

4      The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

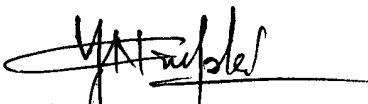
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elhilo

August 8, 2002



YOGENDRA N. GUPTA  
SUPERVISORY PATENT EXAMINER  
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